UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/675,677	09/29/2000	Leo J. Campbell	8049.0001	1495

22852 7590 06/15/2009

FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP
901 NEW YORK AVENUE, NW
WASHINGTON, DC 20001-4413

EXAMINER	
BROWN, CHRISTOPHER J	

ART UNIT	PAPER NUMBER
2439	

MAIL DATE	DELIVERY MODE
06/15/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	09/675,677	CAMPBELL ET AL.	
	Examiner	Art Unit	
	CHRISTOPHER J. BROWN	2439	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *01 May 2009*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-4,6,8-15 and 20-26* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-4,6,8-15 and 20-26* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *5/1/09*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

The Request for Continued Examination has been accepted an entered.

Response to Arguments

Applicant argues that Haber does not teach an electronic mail address and message sent from a sender of the recipient. The Examiner has included Byrd US 6,081,899, which was used in the previous rejection to claims 10, and 20, to overcome this limitation.

Applicant argues that Haber teaches away from the proposed combination because Haber teaches storing a log file at the client. Thus Haber could not be combined with other prior art that stores the log file at the application or authentication server.

The examiner argues that this is not correct. To teach away Haber must state that the log file cannot be stored at the application or authentication server. Haber does not state this, Haber merely teaches that the log is stored in another location. It is well known in the art to store logs or records in more than one location for various reasons including back up copies, and verification reasons.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-6, 8, 9 10-13, 15, 20-23, 25, and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Haber Re. 34,954 in view of Pasieka US 6,587,945 in view of Falls US 6,247,149 in view of Byrd US 6,081,899.

As per claim 1, Haber teaches receiving the electronic message from a sender (from Author to TSA) (Col 2 line 65 – Col 3 line 10). Haber teaches creating a digest of the message data (hashing the document) (Col 3 lines 10-20). Haber teaches sending the hash value to an authentication server (Sending to TSA), (Col 3 lines 1-5). Haber teaches generating as electronic postmark data structure by the authentication server, the electronic postmark data structure including the hash value, item and date information and a value that uniquely identifies the electronic postmark data structure (sequential receipt number, hash, current time) (Col 4 lines 13-17). Haber teaches signing the digest, temporal stamp, and unique value with a digital signature (certified with the TSA signature) (Col 4 lines 25-29). Haber teaches sending the digest, time stamp, unique value, and signature to the electronic address as an electronic postmark (transmitted to the author). Haber teaches authenticating the digest temporal stamp unique value and digital signature (Confirm Document Hash, time stamp, etc by signing the data) (Col 7 lines 20-45). Haber teaches storing the certificate with the client (Col 7 lines 30-35).

Byrd teaches sending the electronic postmark data structure and the recipient electronic address from the authentication server to a recipient client (Outgoing mail server acts as time stamp authority and sends message from User A to User B) (Col 3 line 60- Col 4 line 5). Byrd teaches authenticating the electronic postmark data structure at the

recipient, (User B determines if the message has been altered or tampered with (Col 3 lines 47-53, Col 4 lines 1-5). Byrd teaches the message is sent from sender A to an electronic mail address of a Recipient B using a message composer. (Col 2 lines 25-35) (Col 4 lines 30-51).

It would have been obvious to one of ordinary skill in the art to use the forwarding system of Byrd with the Authority of Haber because it allows a sender to prove to anyone the time at which their document was created.

Pasieka teaches storing notarization information at the authentication server (Col 2 lines 5-15).

It would have been obvious to keep a copy of the postmark structure at the server because it allows a copy for redundancy and log of activities to be kept.

Falls teaches creating a log with a digest (checksum) of the file (Col 7 lines 10-15).

It would have been obvious to one of ordinary skill in the art to use the log of Falls with the System of Haber-Pasieka because its checksum proves the log is not corrupted

As per claim 2, Haber teaches the step of creating a digest comprises generating a one way hash value of the message (Col 3 lines 17-20).

As per claim 3, Haber teaches a temporal stamp using the time and date which indicate when the message was received (Col 6 lines 22-26).

As per claim 4, Haber teaches sending the digest, temporal stamp, unique value and digital signature comprising the electronic message (Col 4 lines 25-30).

As per claim 5 Haber teaches the electronic address is the address of the sender (electronic address of the author) (Col 4 lines 25-30).

As per claim 6, Haber teaches that the electronic message has a signature legally proving the date from the trusted Time Stamp Authority (Col 4 lines 30-35, Col 2 lines 28-35).

As per claim 9, Haber teaches verifying the digital signature was signed by the official entity (using the correct key) verifying the specific identity of the entity which signed the digital signature (by using the correct key) and authenticating the contents of the electronic message using the digest (by comparing hashes) (Abstract, Col 7 lines 20-30).

As per claim 8, Falls teaches creating a log with a digest (checksum) and timestamp of the file (Col 7 lines 10-15).
Pasieka teaches signing a log, (Column 11, lines 1-20).
It would have been obvious to use the digital signature of Pasieka with the log because it allows the integrity and origination of the log to be proved (Col 2 lines 1-4).

As per claim 10, 20 Haber teaches receiving the electronic message from a sender (from Author to his client) (Col 2 line 65 – Col 3 line 10). Haber teaches creating a hash of the

message data (hashing the document) (Col 3 lines 10-20). Haber teaches appending a temporal stamp and a unique value to the digest (sequential receipt number, hash, current time) (Col 4 lines 13-17). Haber teaches signing the digest, temporal stamp, and unique value with a digital signature (certified with the TSA signature) (Col 4 lines 25-29). Haber teaches sending the digest, time stamp, unique value, and signature to the electronic address as an electronic postmark (transmitted to the author).

Haber teaches authenticating the digest temporal stamp unique value and digital signature (Confirm Document Hash, time stamp, etc by signing the data) (Col 7 lines 20-45). Haber teaches storing the certificate (Col 7 lines 30-35).

Haber fails to teach sending the electronic postmark data structure and the recipient electronic address from the authentication server to a recipient client. Haber does not teach a log file or a digest of the log.

Byrd teaches sending the electronic postmark data structure and the recipient electronic address from the authentication server to a recipient client (Outgoing mail server acts as time stamp authority and sends message from User A to User B) (Col 3 line 60- Col 4 line 5). Byrd teaches authenticating the electronic postmark data structure at the recipient, (User B determines if the message has been altered or tampered with (Col 3 lines 47-53, Col 4 lines 1-5).

It would have been obvious to one of ordinary skill in the art to use the forwarding system of Byrd with the Authority of Haber because it allows a sender to prove to anyone the time at which their document was created.

Byrd does not teach storing a log.

Pasieka teaches storing notarization information at the authentication server (Col 2 lines 5-15).

It would have been obvious to keep a copy of the postmark structure at the server because it allows a copy for redundancy and log of activities to be kept.

Falls teaches creating a log with a digest (checksum) of the file (Col 7 lines 10-15).

It would have been obvious to one of ordinary skill in the art to use the log of Falls with the System of Haber because its checksum proves the log is not corrupted.

As per claim 11 , Haber teaches that the electronic message has a signature legally proving the date from the trusted Time Stamp Authority (Col 4 lines 30-35, Col 2 lines 28-35).

As per claims 12, and 13, 23 Haber teaches generating a digital signature and authenticating the electronic postmark data, which includes the signature, using a digital key (using the RSA method so that the public key authenticates, and private key signs), (Abstract, Col 7 lines 4-8).

As per claim 15, 22 Haber teaches the authentication server is the electronic postmark server (TSA creates the authentication data to make an electronic postmark) (Col 4 lines 12-16).

As per claim 21, Byrd discloses the use of the Internet (Col 4 line 6). The examiner takes official notice that TCP/IP is widely used on the internet.

As per claims 25, and 26, Haber fails to teach sending the electronic postmark data structure and the recipient electronic address from the authentication server to a recipient client.

Byrd teaches sending the electronic postmark data structure and the recipient electronic address from the authentication server to a recipient client (Outgoing mail server acts as time stamp authority and sends message from User A to User B) (Col 3 line 60- Col 4 line 5).

It would have been obvious to one of ordinary skill in the art to use the forwarding system of Byrd with the Authority of Haber because it allows a sender to prove to anyone the time at which their document was created.

Claims 14, and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Haber Re. 34,954 in view of Falls US 6,247,149 in view of Byrd US 6,081,899 in view of X.509.

As per claim 14, 24 Haber teaches sending a digital signature and certificate with the data to the user, but does not explicitly teach that the public key is included in the certificate. X.509 discloses that the X.509 certificate standard is widely accepted and that the certificate contains the subject's public key.

It would be obvious to one skilled in the art to use the X.509 standard because it is widely used, secure and flexible.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to CHRISTOPHER J. BROWN whose telephone number is (571)272-3833. The examiner can normally be reached on 8:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kambiz Zand can be reached on (571)272-3811. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Christopher J Brown/ 6/8/09
Primary Examiner, Art Unit 2439